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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/898,707	07/03/2001	Thomas Zickell	NEI-010XX	2439

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EXAMINER

AUGHENBAUGH, WALTER

ART UNIT PAPER NUMBER

1772

DATE MAILED: 09/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/898,707

Applicant(s)

ZICKELL, THOMAS

Examiner

Walter B. Aughenbaugh

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 16 August 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☒ Applicant's reply has overcome the following rejection(s): See continuation sheet

6. ☐ Newly proposed non-allowable

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.

Claim(s) objected to: none.

Claim(s) rejected: 1-9 and 11-15.

Claim(s) withdrawn from consideration: 16-20.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____

13. ☐ Other: _____

ADVISORY ACTION

Acknowledgement of Applicant's Amendments

1. The After Final Amendment (Amdt. E) filed August 16, 2005 has been received, considered and entered by Examiner.

WITHDRAWN REJECTIONS

2. The 35 U.S.C. 112 rejection of claim 2 that was repeated in paragraph 3 of the previous Office Action mailed May 18, 2005 has been withdrawn due to Applicant's amendment in claim 2 in Amdt. E.

REPEATED REJECTIONS

Claim Rejections - 35 USC § 112

3. The 35 U.S.C. 112 rejection of claim 14 that was repeated in paragraph 3 of the previous Office Action mailed May 18, 2005 has been repeated for the reasons previously made of record. It is stated in paragraph 3 of the previous Office Action mailed May 18, 2005 that claim 14 recites "a granular material" in singular form in the 11th line of the claim: the recitation "the granular materials" recites a plurality of granular materials, i.e. more than one type of granular material. There is therefore a lack of antecedent basis for the "the granular materials" recitation because the 11th line of the claim recites "a granular material", i.e. one type of granular material.
4. The 35 U.S.C. 112 rejection of claims 1 and 14 made of record in paragraph 5 of the previous Office Action mailed May 18, 2005 has been repeated for the reasons previously made of record. It is stated in paragraph 5 of the previous Office Action mailed May 18, 2005 that the structure intended to be recited by the term "proximate" cannot be ascertained. The amendments in claims 1 and 14 in Amdt. E do not address this basis for rejection. The scope of the structure

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intended to be delineated by the term “proximate” cannot be ascertained because recitation, for instance, that support surface A is proximate to layer B in a multilayer film of layers B and C does not preclude the condition where C is actually closer to A than B is, but Applicant seems to intend to claim that the lower surface is closer to the support surface than the upper surface is. Furthermore, that which is intended to be recited by the recitation “adapted to be disposed” cannot be ascertained because recitation that something is adapted to be something does not positively recite any structure of the claimed article.

Claim Rejections - 35 USC § 103

5. The 35 U.S.C. 103 rejection of claims 1-9 and 11-15 that was repeated in paragraph 4 of the previous Office Action mailed May 18, 2005 has been repeated for the reasons previously made of record.

Response to Arguments

6. Applicant’s arguments regarding the 35 U.S.C. 112 rejection of claim 14 that was repeated in paragraph 3 of the previous Office Action mailed May 18, 2005 presented on page 10 of Amdt. E and the bottom of page 11-page 12 of Amdt. E have been fully considered but are not persuasive. Applicant states that “Applicant is still entirely unclear” why claim 14 is indefinite on page 10 of Amdt. E, but it is stated in paragraph 3 of the previous Office Action mailed May 18, 2005 that claim 14 recites “a granular material” in singular form in the 11th line of the claim: this was stated in paragraph 3 of the previous Office Action mailed May 18, 2005 because this is the reason for the rejection under 35 U.S.C. 112. The point is further supported in the repeated 35 U.S.C. 112 rejection of claim 14 provided above in this Advisory Action, although the basis for the rejection was made crystal clear in the previous Office Action mailed May 18, 2005. In

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regard to Applicant's arguments on page 11-12 of Amdt. E., again, it is stated in paragraph 3 of the previous Office Action mailed May 18, 2005 that claim 14 recites "a granular material" in singular form in the 11th line of the claim, so this is the reason for the rejection under 35 U.S.C. 112. Recitation of "granular material" followed by "the granular materials" renders the claim indefinite for the reasons provided above in this Advisory Action. Furthermore, this discrepancy makes it unclear whether or not Applicant intends to actually claim that the covering material comprises more than one type of granular material.

7. Applicant's arguments regarding the 35 U.S.C. 112 rejection of claims 1 and 14 made of record in paragraph 5 of the previous Office Action mailed May 18, 2005 presented on pages 12-14 of Amdt. E have been fully considered but are not persuasive. Applicant states that the term "proximate" "is not intended to define 'structure'", but the term "proximate" is necessarily intended to define structure in that "orientation of the upper and lower surfaces of the substrate [relative to the support surface to which the covering material is applied]" is structure. Applicant argues that claims 1 and 14 specify the "orientation of the upper and lower surfaces of the substrate [relative to the support surface to which the covering material is applied]", but the basis of the rejection is that the language of claims 1 and 14 actually do not specify the orientation of upper and lower surfaces of the substrate relative to the support surface to which the covering material is applied: see the repeated 35 U.S.C. 112 rejection of claims 1 and 14 above in this Advisory Action.

8. Applicant's arguments regarding the 35 U.S.C. 103 rejection of claims 1-9 and 11-15 that was repeated in paragraph 4 of the previous Office Action mailed May 18, 2005 presented on pages 14-20 of Amdt. E have been fully considered but are not persuasive.

The rejection of record is not based on the assertion that the location of the clean surface area relative to the substrate is a matter of “design choice”. The Office’s position as to what is “well known” is stated clearly on the record (e.g., Applicant provides a relevant portion of the previous Office Action on pages 15-16 of Amdt. E). On page 16 of Amdt. E, Applicant focuses on the “depending on the particular desired end result” phrase in the rejection. Applicant states that “the Examiner stated [in the Office Action mailed July 29, 2004] that the desired end result of the modification to Kennepohl is to ‘provide a continuous impervious layer as taught by McGroarty et al.’”, but the Office Action never labeled the phrase to “provide a continuous impervious layer as taught by McGroarty et al.” as a desired end result. The “particular desired end result” phrase refers to the particular desired end result of one of ordinary skill in the art: one of ordinary skill in the art would have recognized to have set the particular orientation of the edge portion 13 depending on the particular desired end result, as stated in paragraph 6 of the previous Office Action mailed May 18, 2005 and cited by Applicant on pages 15-16 of Amdt. E. Applicants relies upon piecemeal analysis of each of the three references in arguments on page 17 of Amdt. E: the proposed combination of references is proper for the reasons provided in the rejection of record. Applicant argues that McGroarty teaches away from the claimed invention because item 13 is arranged “to avoid exposing the bentonite layer 11 to water”, but the granular material is taught by Kennepohl: McGroarty discloses a well known lap structure that is used to ensure continuous impermeability and is not relied upon for a teaching of granular material. The “difficulty” of bonding adjacent sheets together allegedly taught by McGroarty is irrelevant: if the sheets are bonded together, they are bonded together, regardless of how difficult it was to do

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so. Proof that using a lap structure (including a clean surface area) to ensure continuous impermeability is well known is provided in McGroarty for the reasons of record.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter B. Aughenbaugh whose telephone number is 571-272-1488. The examiner can normally be reached on Monday-Thursday from 9:00am to 6:00pm and on alternate Fridays from 9:00am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Walter B. Aughenbaugh

09/07/05

WBA


HAROLD PYON
SUPERVISORY PATENT EXAMINER

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9/7/05